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WILLIAM H. BOLLMAN
MANELLI DENISON & SELTER PLLC
2000 M STREET, NW
SUITE 700
WASHINGTON, DC 20036-3307

EXAMINER

STRANGE, AARON N

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. SMITH, ORVILLE A. PIKE, and
JOHANNA WILSON

Appeal 2007-004434
Application 09/525,926
Technology Center 2400

Decided: July 21, 2009 ¹

Before JOSEPH L. DIXON, JEAN R. HOMERE, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-8, 11, 12, 20-27, 30, 31, 39-46, and 49-56. Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

The invention at issue on appeal relates to a mobile originated Internet relay chat. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method of providing access to a channel of an Internet Relay Chat group to a wireless mobile device, comprising:

placing a mobile chat proxy server in a communication path between a standard Internet Relay Chat server and a wireless Internet gateway server;

receiving a first message from a non-Internet Relay Chat program adapted to be executed by said wireless mobile device at said mobile chat proxy server;

converting said first message to a second message compatible with said standard Internet Chat Relay [sic, Internet Relay Chat or IRC] server with said mobile chat proxy server; and

forwarding said second message to said standard IRC server from said mobile chat proxy server.

C. REFERENCES

The Examiner relies on the following references as evidence:

Burgan	US 6,459,892 B2	Oct. 1, 2002 (filed Sep. 26, 2001)
Bunney	US 6,446,112 B1	Sep. 3, 2002 (filed Mar. 17, 1999)
Ramasubramani	US 6,314,108 B1	Nov. 6, 2001 (filed Apr. 30, 1998)
Gudjonsson	US 6,564,261 B1	May 13, 2003 (filed May 9, 2000)

USENET posting of cl00bie@my-deja.com to alt.online-service.webtv, WebTV to IRC Proxy debuts on SorceryNet, <http://www.google.com/groups> (Oct. 18, 1999, 19:31: 59 GMT) (last visited Aprl. 28, 2004).

D. REJECTIONS

The Examiner rejects the claims on appeal as follows:

Claims 1-7, 11, 12, 20-27, 31, 39-45, 49 and 50 stand rejected under 35 USC 103(a) as being unpatentable over Burgan and further in view of Bunney; WebTV Posting and Ramasubramani.

Claims 8, 46, 51-56 stand rejected under 35 USC 103(a) as being unpatentable over Burgan, Bunney, WebTV Posting, Ramasubramani, and further in view of Gudjonsson.

II. ISSUE

Have Appellants shown the Examiner erred in combining Burgan, Bunney, WebTV Posting and Ramasubramani to render the claimed invention unpatentable?

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the

consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

AT the outset, we note that on August 17, 2005, Appellants submitted an after final amendment to incorporate the limitations of dependent claim 9 into independent claim 1 and to cancel dependent claim 9.

The Examiner indicated in the advisory action mailed on August 31, 2005 that the amendment would be entered and clarified that the "amended claims remain unpatentable under 35 U.S.C. § 103(a) in view of Burgan, Bunney, WebTV posting, and Ramasubramani." (Advisory Action 3.) The rejection of the amended independent claims will be under the same rationale as that stated in the final action together with the rejection of claim 9." (*Id.*)

The Examiner clearly indicated that the grounds of the rejection would be over the combination of the four references rather than the three

references applied in the final office action. In the first Examiner's Answer, mailed on May 3, 2006, the Examiner again indicated the appropriate basis for the rejection is under the combination of the four references rather than the three references applied in the final rejection due to Appellants' claim language amendment.

In the Appellants' Supplemental Appeal Brief, filed on January 4, 2007, Appellants again restate the incorrect grounds of rejection, which are on review due to Appellants' amendment to the claim language and continued to argue only the rejection as presented in the Final rejection for the unamended claims. (Supp. App. Br. 4, 5-11.) With the amendment to each of the independent claims to incorporate limitations from the dependent claims and a clear indication from Examiner of the appropriate basis for the rejection in the advisory action, Appellants should have received clear notice as to the basis of the rejection on appeal. After repeated notifications by the Examiner, appellants still have never addressed the rejection on appeal.

Therefore, Appellants have not responded to the correct rejection on review, as clearly set forth by the Examiner in the administrative record. We pro forma affirm the Examiner's rejection since Appellants have not shown any error in the rejection, which has not been addressed in either the Brief or the Reply Brief.

For completeness, we will address Appellants' arguments and the rejection.

With respect to independent claim 1, in Appellants' amended/updated Brief, filed on January 4, 2007 after the first Examiner's Answer (identifying Appellants' incorrect statement of the grounds of rejection), Appellants merely referred to the Examiner's stated rejection prior to the Amendment

after Final rejection. Therefore, we find it difficult to find any of Appellants' arguments persuasive.

Appellants argue that the Examiner has relied upon improper hindsight reconstruction since the primary reference to Burgan does not discuss a connection to the Internet or a mobile chat proxy server. (App. Br. 5-6.) Here, Appellants take advantage of the claim language amendment made after final rejection, but argue the rejection made prior to the amendment. Therefore, Appellants' arguments to hindsight and lack of suggestion or incentive are not persuasive of error in the Examiner's rejection since they do not address the Examiner's stated rejection.

With respect to independent claim 1, Appellants argue that nothing in Bunney discloses or suggests any applicability to unique problems associated with wireless mobile devices, much less a system and method of sending a first message from a non-Internet relay chat program adapted to be executed by a wireless mobile device to a mobile chat proxy server and forwarding a second message compatible with a standard Internet relay chat server to a standard Internet relay chat server. (App. Br. 7.) The instant claim language merely sets forth the recited steps and does not address or identify how these unclaimed problems are solved or addressed. Therefore, arguments to unclaimed subject matter are not persuasive of error in the Examiner's initial showing of obviousness.

With respect to the proposed combination of teachings and motivations set forth by the Examiner, Appellants merely address the Examiner's motivation by stating that it is "nonsensical" and address the merits of the final rejection rather than the rejection, as necessitated by Appellants' amendment to the claim language of independent claim 1.

Appellants' argument additionally treats the modifications to be the Burgan reference as a bodily incorporation modifying Bunney rather than what the collective teachings of the references would have suggested to one of ordinary skill in the art at the time the invention was made. Rather, one of ordinary skill would look at Bunney concerning IRC name translation and the skilled artisan would modify those teachings to be used with wireless mobile devices as disclosed by Burgan. Therefore, we find Appellants' argument to be unpersuasive of error in the combination relied upon by the Examiner in the rejection.

With respect to WebTV, Appellants argue that WebTV lacks any functionality to wireless mobile devices and a combination therewith would further be "nonsensical." (App. Br. 8.) Again, Appellants are evaluating each reference in a vacuum rather than what the combination would have suggested to one of ordinary skill in the art at the time the invention was made and as relied upon by the Examiner in the stated rejection. The Examiner merely relies upon the teachings of WebTV to evidence that a chat proxy for this limited WebTV system is used to allow full participation in IRC networks. We agree with the Examiner that WebTV teaches and fairly suggests that a proxy may be used by those systems, which cannot directly interface within IRC server. Therefore, we find Appellants' argument to be unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to independent claim 1, we note that Figure 5 of Bunney teaches the use of a sender, who is connected to a chat proxy 39 communicating to an IRC server 40. The chat proxy 39 functions as a converting means to place the communications in a proper format for the IRC server 40. While IRC server 40 is connected to the proxy, which is

connected to the client/sender 3, Bunney does not expressly teach that the client is a wireless device connected through the Internet/network 2.

Therefore, the Examiner relies upon the teachings of Burgan (Ans. 4) with respect to placing a mobile chat proxy server in direct communication path between mobile units 36 and a system controller 46 with a wireless gateway server (and Ramasubramani to evidence the well-known use of a wireless Internet gateway server) (Ans. 6). While we agree with the Examiner's combination of the teachings, we note that the teachings of Bunney go further than the Examiner has relied upon. For example, Bunney at column 3, lines 18-21, teaches and fairly suggests the use of the invention for "cross-platform support for intelligent devices such as telephones, televisions, or personal digital assistance." While not clearly shown in the figures, it appears that the clients/users 3 may be a PC, laptop, or other intelligent device such as telephones, or PDAs. Hence, we find that Bunney similarly teaches interfacing a mobile unit to a chat proxy. Bunney discloses the use of a front end processor 16 and figure 2, which connects the client to the IRC 20 or as shown in Figure 5 connecting to the IRC server through chat proxy 39 to client 3 via Internet/network 2. The Examiner has incorporated the teachings of Ramasubramani in Figures 1 and 2 to evidence the use of proxy server/network gateway connected to the Internet used between a mobile user and a server. Ramasubramani further teaches a method for providing data from a wired network to wireless communication devices, Ramasubramani further teaches that the advantage of the invention is that the application servers on the Internet are able to provide information to subscribers of wireless networks without dealing with the myriad of different wireless network characteristics. (Col. 4, ll. 39-46.)

While the Examiner's combination of teachings may appear, at first glance, to be attenuated, as Appellants argue throughout the Brief and Reply Brief, a reasoned study of the totality of the four (4) prior art teachings evidence the recognition in the prior art of interfacing a wireless unit to a wired processing network and a recognition of a translation of non-IRC chats to the IRC standard to allow non-IRC devices to participate in IRC chats. We find Appellants' arguments throughout the Brief and the Reply Brief to merely address the individual shortcomings of each of three references, which Appellants have chosen to respond to in the rejection and leaves Ramasubramani out of any arguments or consideration. Therefore, Appellants' arguments do not address the merits of the rejection as set forth by the Examiner and do show error therein. (Reply Br. 5.)

With respect to dependent claim 12 and the Examiner's use of the word "inherently" in addressing the "ghosting command" aspects of the Bunney reference, Appellants attack the Examiner's use of the word, "inherent" rather than addressing the merits of the position advanced by the Examiner. (Ans. 12.) It appears that the Examiner merely advances that it would have been obvious to one of ordinary skill in the art at the time the invention was made in light of the teachings of WebTV to use all of the well-known mode commands that are available in standard IRC chats, "ghosting command" being one of the well-known mode commands. Rather than address the merits of the Examiner's position, Appellants attack the express wording of the Examiner's position. (Reply Br. 1-2.) We find Appellants' argument to be unpersuasive of error in the Examiner's position concerning the obviousness of the claimed invention and the use of the well-

known "ghosting" command. The improvement of using a well-known ghosting command for its known function represents no more than the predictable use of prior art elements according to their established functions, and thus would have been obvious. *See KSR*, 550 U.S. at 417. Appellants have provided no evidence to show that using a well-known ghosting command was "uniquely challenging or difficult for one of ordinary skill in the art." *Leapfrog Enters., Inc.* at 1162.

Appellants have provided no evidence that a ghosting command would not have been readily apparent as a desirable function to be performed in a system using a wireless mobile device. Appellants merely contend that the Examiner has failed to establish as a "certainty" that WebTV can process a ghosting command since ghosting is not required to participate in an IRC session. (App. Br. 9-10.) Nor do we find Appellants' analogy to a foreign language in the Reply Brief at pages 6-7 to be persuasive of error in the Examiner's initial showing of obviousness. As discussed above, we do not find that the instant obviousness rejection requires "certainty," but we are determining whether it would have suggested to one of ordinary skill in the art at the time of the invention to use of all well-known mode commands. We find that WebTV would have suggested the use of a well-known ghosting command. Therefore, we find that Appellants have not shown error in the Examiner's initial showing of obviousness over the combined teachings of the four references.

With respect to dependent claims 6, 7, and 9, we will address Appellants' arguments with respect to representative dependent claim 6. Appellants rely upon the same arguments advanced with respect to independent claim 1 which we found unpersuasive of error. Appellants

additionally contend that Ramasubramani discloses a proxy server that interconnects various wireless network carriers having different wireless network characteristics, but Ramasubramani fails to disclose any of those wireless network carriers having IRC capability, much less rely on an IRC server. Appellants further contend that Ramasubramani fails to disclose or suggest a wireless Internet gateway server much less a “SINGLE” reference that discloses any non-Internet relay chat program adapted to be executed by a wireless mobile device used to communicate with a standard IRC server. (App. Br. 11-12.) While a single reference would be required for anticipation, it is not required for obviousness rejection. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness.

With respect to claims 8, 46, and 51-56, Appellants set forth a single heading for all these claims. Therefore, we treat Appellants' heading as an attempt to group the claims together. Therefore, we select dependent claim 8 and address Appellants' arguments thereto. Claims 46 and 51-56 will be grouped with the dependent claim 8. Appellants rely upon the same arguments advanced with respect to independent claim 1 and address only the three reference combination rather than the four reference combination relied upon by the Examiner. Appellants further contend that the Examiner's reliance upon the teachings of Gudjonsson does not remedy the deficiencies in the Examiner's base combination of the three references. (App. Br. 13-14.) Since Appellants' arguments do not address the Examiner's combination of references, Appellants' arguments cannot show error in the Examiner's initial showing of obviousness. Furthermore, as discussed above, we found Appellants' argument to independent claim 1 to be

unpersuasive of error in the Examiner's initial showing of obviousness. Therefore, we will sustain the Examiner's rejection of dependent claim 8 and claims 46 and 51-56 grouped therewith by Appellants.

With respect to Appellants' arguments concerning the ghosting command in dependent claims 52, 54 and 56, Appellants rely upon the same arguments advanced with respect to claims 12, 31, and 50. Since we found Appellants' arguments unpersuasive with respect to claim 12, we similarly find them unpersuasive to representative claim 52.

With respect to Appellants' argument set forth in the Reply Brief, Appellants again argue the three reference combination, rather than the four reference combination indicated in the Advisory Action and in the Examiner's Answer. Therefore, Appellants' arguments cannot show error in the Examiner's stated rejection. Appellants reiterate arguments advanced in the Brief, which we found unpersuasive of error. (Reply Br. 1-3.) Appellants further contend that Appellants' claims are specifically directed towards wireless mobile devices, not towards generically limited capability device, as the Examiner maintains in the Answer at page 11. (Reply Br. 3.) Appellants' contend that the characteristics of the wireless mobile devices that conventionally lack the ability to participate in IRC, are very basic devices, with very simple operating systems and a very limited amount of memory to store and execute programs. Appellants contend that WebTV's and Bunney's devices do not address the same problem of adding IRC capability to a mobile wireless device that conventionally lacks the ability to participate in an IRC. (Reply Br. 3-4.) We find that Appellants' contentions and distinctions are not supported by the express plain language as recited in

independent claim 1. Therefore, Appellants' arguments are unpersuasive of error in the Examiner's initial showing of obviousness.

With respect to Appellants' arguments regarding the modifications to the Burgan reference, Appellants have argued that the Burgan reference is the only one of the three references that is concerned with wireless mobile devices and that all of the modifications must stem from this teaching and that the Burgan reference is completely within a telephone network. Appellants contend that the Examiner has still failed to address why one of ordinary skill would have modified Burgan conveniently to arrive at the claimed features. Appellants further contend that the Burgan reference "teaches away" from connecting a mobile wireless device to an IRC chat session. (Reply Br. 3-5). We find that Appellants are considering the teachings of the prior arts individually, not as a whole, and do not address the Examiner's stated rejection. Therefore, we find Appellants' arguments to be unpersuasive of error in the Examiner's initial showing of obviousness of independent claim 1.

Appellants acknowledge the Examiner's reliance on the teachings of Ramasubramani at page 5 of the Reply Brief and then contend that this is a new rejection not made during prosecution. We disagree with Appellants' contention and find that Appellants' amendment to independent claim 1 after final rejection necessitated the Examiner's inclusion of the teachings of Ramasubramani as clearly applied in the final rejection to dependent claim 9, which was incorporated into independent claim 1. Furthermore, the Examiner clearly indicated the change of grounds of the rejection in the Advisory Action and in the Examiner's Answer. Appellants have had due notice of the change. However, Appellants have elected not to address the

rejection as clearly set forth by the Examiner. Therefore, Appellants' contention of a new ground for rejection is not supported by the administrative record. Furthermore, Appellants did not petition this petitionable matter, which is not within the Board's jurisdiction.

Appellants further contend that adding a wireless Internet gateway to the teachings of Burgan would change the principle of operation of the prior art invention being modified, and that the Examiner's rejection uses reverse logic. (Reply Br. 5-6.) Here, we find Appellants' arguments merely address the teachings of the Burgan reference in isolation and do not address the Examiner's stated rejection. Therefore, Appellants' arguments are unpersuasive error in Examiner's initial showing of obviousness of independent claim 1.

With respect to dependent claim 12, Appellants reiterate the arguments advanced in the Brief, which we found unpersuasive of error. Therefore, the arguments are unpersuasive of error in the Examiner's initial showing of obviousness of dependent claim 12.

VI. CONCLUSION

For the aforementioned reasons, the Appellants have not shown the Examiner erred in the obviousness rejection based upon the combination of Burgan, Bunney, WebTV Posting, and Ramasubramani.

VII. ORDER

We affirm the obviousness rejections of claims 1-8, 11, 12, 20-27, 30, 31, 39-46, and 49-56.

No time period for taking any subsequent action in connection with

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Application 09/525,926

this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
§ 1.136(a)(1)(iv) (2007).

AFFIRMED

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WILLIAM H. BOLLMAN
MANELLI DENISON & SELTER PLLC
2000 M STREET, NW
SUITE 700
WASHINGTON, DC 20036-3307